REMARKS

This response is being filed in reply to the Office Action mailed August 29, 2008. That Office Action followed Applicant's amendment in which it canceled those claims indicated in the Board's Decision on Appeal to be unpatentable in view of Dimitriadis and Hite. In the Office Action, the remaining pending claims 26-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dimitriadis in view of Hite. This rejection is traversed for the reasons discussed below.

Applicant submits that the rejection is improper for at least two reasons: 1) it is impermissibly in conflict with the Board's findings in its Decision on Appeal and 2) it does not establish a *prima facie* case of obviousness. With regard to the first reason, it is clearly implicit in the Decision on Appeal that the Board determined the invention of claims 26-42 to be patentable over Dimitriadis and Hite. After reversing the Examiner's rejection of claims 1-13, 16-19, and 21-41 under 35 U.S.C. § 102(b), the Board *sua sponte* considered patentability of these claims in view of a combination of Dimitriadis and Hite, and determined that, of these claims, 1-13, 16-19, and 21-25 were unpatentable over the two references. It therefore entered a new ground of rejection of these claims based on the two references. Clearly implicit in this action is the unavoidable conclusion that the Board determined that claims 26-41 were not rendered obvious by the combination of Dimitriadis and Hite. That is, the Board clearly went beyond the Examiner's rationales and findings and made its own determination of patentability and obviousness and, in doing so, decided that claims 26-41 should not be rejected on the basis of these two references. Thus, Applicant submits that it is improper for the Examiner to now take action directly contrary to that Board determination. More egregious is the reconstituted rejection of claim 42 on the basis of these two references. That claim was already before the Board as being rejected under 35 U.S.C. § 103(a) on the basis of these two references and the rejection was overturned by the Board. Accordingly, it is improper for the Examiner, and it is Applicant's belief that the Examiner is without authority, to now re-reject the claim on the basis of those references. Accordingly, withdrawal of the rejection of claims 26-42 is respectfully requested.

Secondly, apart from the rejection being contrary to the Board's decision, it fails to establish a *prima facie* case of obviousness based on the references. For example, as discussed

in Applicant's Reply Brief, Fig. 2 of Dimitriadis shows that it plays advertising in a manner different than that recited in claim 26, and the Examiner has not pointed to anything from Hite that would lead one skilled in the art to alter Dimitriadis' approach in the manner recited in claim 26. In particular, claim 26 recites, *inter alia*, that the "advertising control unit is operable to access one of the stored radio advertisements, with the accessed radio advertisement being inserted into the advertising slot identified by the received marker so that the accessed radio advertising is included within the audio content sent to the input of the vehicle radio." Thus, in the invention of claim 26, the audio content sent to the vehicle radio includes the received radio broadcast together with the inserted advertisement, whereas in Dimitriadis' system as shown in Fig. 2, the advertising is sent to the speaker amplifier 68 independently of the received voice broadcast. This difference has a practical advantage; namely, Applicant's system can be used with conventional integrated vehicle radio/speaker systems without requiring modification to provide an auxiliary input to the amplifier.

This distinction was expressly adopted by the Board in its reversal of the rejection of claim 26. See page 10, lines 1-21 of the Decision on Appeal. Moreover, in addressing the rejection of dependent claim 42 under 35 U.S.C. § 103(a), the Board went on to consider whether Hite made up for this deficiency of Dimitriadis. The Board was not able to identify the missing teaching or suggestion from Hite and therefore reversed the rejection. See page 13, lines 9-26 of the Decision on Appeal. Nor has the Examiner identified any such teaching or suggestion from Hite. Accordingly, Applicant respectfully submits that the rejection should be withdrawn. Reconsideration is therefore requested.

The Commissioner is hereby authorized to charge Deposit Account No. 07-0960 for any required fees, or credit any overpayment associated with this communication.

Respectfully submitted,

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